

REMARKS

Claims 1-9, and 13-25 are pending in the application.

Claim 17 has been amended. Claims 10-12 were previously canceled without prejudice.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

Claim 17 was rejected under 35 U.S.C. § 112, second paragraph, as failing to distinctly claim the present invention. Claim 17 has been amended to have it depend from claim 3. Accordingly, reconsideration and withdrawal of the rejection of claim 17 under 35 U.S.C. § 112, second paragraph is respectfully requested.

Claim Rejections under 35 U.S.C. § 102

Claims 1-9, 16, and 20-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Markowitz et al., U.S. Patent No. 6,311,185 B1 (hereinafter “Markowitz”) in view of Yu, U.S. Patent No. 6,067,552 (hereinafter “Yu”). Claims 13-15 and 17-19 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Markowitz in view of Yu.

Applicants reiterate the arguments presented in the Preliminary Amendment of December 19, 2003 in describing the contents of Markowitz reference. Applicants respectfully contend that the Examiner is mis-interpreting the disclosure of the Markowitz reference. For example, on page 20 of the Office Action, the Examiner points out that “Markowitz does mention selecting a related advertisement to a web page based on the attributes of the requested Web page.” The Examiner seeks to give the term “attributes” a broad meaning to include content data, such as the data referred to in the claims (e.g, claim 1). Markowitz, however, does define this term in the specification. Particular attention is drawn to claims 11 and 12 of Markowitz. There, the term “attributes” is defined to relate to how to put an advertisement into an HTML page (based on the presence and location of text

and graphics or the colors of the text). In other words, nowhere in Markowitz is it suggested that the term “attributes” has a meaning in line with the currently pending claims (see, also, Column 3, lines 19-37). The problem that Markowitz is dealing with is how to best place an advertisement given what a web-page looks like, not based on its informational content (e.g., what the page is about).

As to the automatic determining a content data of a given information unit and selecting a chosen information unit, as recited in claim 1, Markowitz provides little disclosure in this area. Column 2, line 65 to Column 3, line 18 provides a very limited description of how an advertisement can be selected for inclusion on a web-page. There is little detail as to what is listed in this section. There is no disclosure as to what is stored in “the history database 21.” There is no disclosure as to how a web page currently being requested can be used to select an appropriate advertisement. When comparing this disclosure to the pending claims, the Office Action attempts to supplement the disclosure of Markowitz. That supplementation, however, comes from the Applicants disclosure and not from any of the cited prior art references.

As to the “history database,” the Examiner states that Markowitz “does disclose the information stored in the database is the advertisements since the database is the advertisement repository database.” (p. 19). It still remains unclear as to how storing advertisements in a history database would lead one to determine content data of the given information unit and selecting a chosen information unit based on it.

As to the content of the web-page, the Office Action says it is “easy to determine what field said web page or web site is related to.” (p. 20). All Markowitz says is that “if a user had previously requested a large number of web pages related to sports, and advertisement for a sporting goods store might be selected.” There is no disclosure as to how this is done (whether it would be “easy” or not). Again, the supplementation of the deficiencies of the Markowitz reference is coming from the present application. Applicants have provided legitimate ways for the Markowitz reference to work outside of the presently claimed

invention. For example, if one selects “espn.com” then that web-address is linked to an advertisement that concerns “sports.” The actual content of the espn.com page is not determined in such an example (except maybe one-time by a service provider).

The Yu reference does not make up for the deficiencies of Markowitz as described in Applicants’ remarks in the Preliminary Amendment of December 19, 2003. Accordingly reconsideration and withdrawal of the rejection of claims 1-9 and 13-24 under 35 U.S.C. § 103(a) is respectfully requested.


CONCLUSION

For all the above reasons, the Applicant respectfully submits that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,
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Dated: 8/3/04

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